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Paper No. 50

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES M. WILLIAMS
and ROBERT F. D'AVELLO

Appeal No. 1998-1398
Application No. 08/400,637

ON BRIEF

Before BARRETT, RUGGIERO, and BARRY, Administrative Patent Judges.

BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the rejection of claims 27-36. We affirm-in-part.

BACKGROUND

The invention at issue in this appeal relates to cordless and cellular telephone systems. Cordless telephone systems typically include a portable handset and an associated base station. The base station is connected to a telephone company

(TELCO) via a landline. A landline telephone number assigned to the base station allows a user to place and receive telephone calls within a limited range of the base station, e.g., within a home.

Cellular telephone systems can provide radiotelephone communications outside the range of cordless telephone systems. Such cellular systems typically include mobile or portable subscriber units and cellular base stations connected to a TELCO via at least one cellular switching network. Cellular telephone numbers respectively assigned to each subscriber unit allow a user to place and receive calls within a widespread range of the cellular base stations, e.g., within a metropolitan area.

Unfortunately, a user who moves between a cordless telephone system and a cellular telephone system may miss an incoming call routed to the system where he is not found. Furthermore, purchasing and operating unique equipment for

both the cordless and cellular telephone systems is costly and inconvenient.

The inventive portable cellular cordless (PCC) unit and cordless base station can be used to place and receive calls in both a cordless telephone system and a cellular telephone system. The invention automatically routes an incoming call to the telephone system in which the PCC unit is found, without inconveniencing the user of the unit. Additionally, it automatically hands-off an in-process call between the cordless and cellular telephone systems when the user moves therebetween.

Claim 27, which is representative for our purposes, follows:

27. A method of maintaining telephone communications between a telephone device having a telephone number and a cellular cordless telephone on one of a cellular telephone system and a cordless telephone system, the cordless telephone system having a cordless base station coupled to a telephone landline having a landline telephone number, the cellular cordless telephone having a cellular telephone number in the cellular telephone system, the cellular cordless telephone having a

transceiver, the method comprising the steps of:

originating and receiving cellular calls, using the transceiver, with the cellular telephone number on cellular radio channels in the cellular telephone system;

originating and receiving cordless calls, using the transceiver, with the landline telephone number on at least one of the cellular radio channels of the cordless base station in the cordless telephone system;

detecting movement of the cellular cordless telephone between the cellular telephone system and the cordless telephone system; and

automatically generating a three way call between the telephone device having the telephone number, the cellular cordless telephone having the cellular telephone number and the telephone landline having the landline telephone number responsive to the step of detecting.

The references relied on in rejecting the claims follow:

Gillig et al. (Gillig '230)	4,989,230	Jan. 29, 1991
Gillig et al. (Gillig '042)	5,127,042	June 30, 1992 (filed Feb. 25, 1991)
Gillig et al. (Gillig '558)	5,367,558	Nov. 22, 1994 (effectively filed Sep. 23, 1988)
Gillig et al. (Gillig '674)	5,463,674	Oct. 31, 1995 (effectively filed Sep. 23, 1988)

Gillig et al. (Gillig '560) 6,141,560 Oct.
31, 2000 (effectively filed Sep. 23,
1988).

We will call these references collectively the "Gillig
references" or the "references."

Claims 27-36 stand rejected under 35 U.S.C. § 112, ¶ 1,
as lacking a written description. Claims 27-30 stand rejected
under § 112, ¶ 1, as non-enabled, and under 35 U.S.C. § 101 as
lacking utility. Claims 31-36 stand rejected under 35 U.S.C.
§ 102(b) as anticipated by Gillig '230 and under 35 U.S.C. §
102(e) as anticipated by Gillig '042, Gillig '558, Gillig
'674, or Gillig
'560.¹ Claims 27-29 stand rejected under 35 U.S.C. § 103(a)
as obvious over Gillig '230, Gillig '042, Gillig '558, or
Gillig '674. Rather than repeat the arguments of the
appellants or examiner in toto, we refer the reader to the

¹ Although the examiner provisionally rejected claims 31-
36 over Application Serial No. 08/654,502, (Examiner's Answer
at 14), the issuance of the Application as the Gillig '560
converted the provisional rejection into a non-provisional
rejection. See M.P.E.P. § 804.I.B (7th ed., July 1998).

second revised appeal brief, (Paper No. 48), and the second answer, (Paper No. 46), for the respective details thereof.²

OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejections made by the examiner. Furthermore, we duly considered the arguments and evidence of the appellants and examiner. After considering the record, we are persuaded that the examiner erred in rejecting claims 27-36 as lacking a written description and in rejecting claims 27-30 as non-enabled and lacking utility. We are also persuaded that he did not err, however, in rejecting claims 31-36 as anticipated by Gillig '230, Gillig '042, Gillig '558, Gillig '674, or Gillig '560.

² Although the appellants also argue, "[t]he examiner erred in objecting to the drawings under 37 CRF [sic] 1.83(a)[,]" (Appeal Br. at 6), such an issue is to be settled by petition to the Director of the U.S. Patent and Trademark Office rather than by appeal to the Board of Patent Appeals and Interferences. See In re Hengehold, 440 F.2d 1395, 1403, 169 USPQ 473, 479 (CCPA 1971).

In addition, we are persuaded that the examiner did not err in rejecting claims 27 and 29 as obvious over Gillig '230, Gillig '042, Gillig '558, or Gillig '674. We are also persuaded, however, that he erred in rejecting claim 28 as obvious over Gillig '230, Gillig '042, Gillig '558, or Gillig '674. Accordingly, we affirm-in-part. Our opinion addresses the following rejections:

- written description rejection of claims 27-36
- enablement rejection of claims 27-30
- utility rejection of claims 27-30
- anticipation rejection of claims 31-36
- obviousness rejection of claims 27-29.

We commence with the written description rejection.

I. Written Description Rejection of Claims 27-36

We begin by noting the following principles. "To fulfill the written description requirement, the patent specification 'must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.'" Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 1479, 45 USPQ2d 1498, 1503 (Fed. Cir. 1998) (quoting In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989)). Fulfillment of the requirement is adjudged "as of the filing

date" of the associated patent application. Vas-Cath, Inc. v. Mahurkar, 935 F.2d at 1566, 19 USPQ2d at 1119. "[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.'" Gosteli, 872 F.2d at 1012, 10 USPQ2d at 1618 (quoting In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976)). With these principles in mind, we consider the examiner's two bases for the rejection.

First, the examiner alleges, "[n]o where [sic] in the specification does it state that the step of generating a three way call and the steps of automatically terminating a path of the three way call is [sic] automatic." (Examiner's Answer at 21.) The appellants argue, "[s]upport in the specification is found, for example, on page 14, line 23 - page 18, line 2." (Appeal Br. at 8.)

Claims 27-30 specify in pertinent part the following limitations: "automatically generating a three way call" Claims 28 and 30 further specify in pertinent part the

following limitations: "automatically terminating a path of the three way call"

The examiner fails to show that the original specification, which includes the original claims, does not describe the limitations. To the contrary, the original specification discloses an "automatic handoff operation" (Spec. at 15.) The automatic handoff operation is explained as automatically generating a three way call and automatically terminating a cellular path of the three way call so that "a call in process is handed off from the cellular telephone system 103 to the cordless telephone system when the PCC 101 relocates from the cellular telephone system 103 to the cordless telephone system." (Id. at 17.)

To generate a three way call automatically, "the PCC 101 receives the landline telephone number of the cordless base station 115 at block 715." (Id. at 16.) Then, "a call in process between the PCC 101 operating in a cellular telephone system 103 and a calling party is handed off from the cellular telephone system 103 to the cordless telephone system by

producing a three way call through the cellular telephone system 103, at block 716, between the PCC 101, the other party and the landline phone number of the cordless base station 115." (Id.) Accordingly, "the cordless base station 115 receives the handoff from cellular to cordless request at block 617 and answers the landline leg of the three way call at block 619 The PCC 101 is now in a cordless phone call with the calling party at block 621." (Id.) To terminate the cellular path of the three way call automatically, "the PCC 101 operating in the cellular telephone system 103 ends the cellular leg of the three way call at block 718 to terminate cellular system communication between the PCC 101 and the other party." (Id. at 17.) In other words, termination of the cellular path occurs "when the PCC 101 relocates from the cellular telephone system 103 to the cordless telephone system." (Id.)

The automatic handoff operation is further revealed as automatically generating another three way call and automatically terminating a landline path of the other three way call so that a call in process is handed off from the

cordless telephone system to the cellular telephone system 103 when the PCC 101 relocates from former to the latter. To generate a three way call automatically, "the PCC 101 operating in a cordless telephone system requests that the cordless base station 115 perform a handoff from the cordless to cellular telephone system 103" (Spec. at 17.) Then, "the cordless base unit performs a three way call between the PCC 101 operating in the cellular telephone system 103, the other party and the landline phone number of the cordless base station 115 at block 625.... the PCC 101 answers the cellular leg of the three way call at block 727 Thus, the PCC 101 is now in a cellular phone call at block 701." (Id.) To terminate a landline path of the three way call automatically, "the cordless base station 115 ends the landline leg of the three way call at block 627 to terminate communication between the calling party and the cordless base station 115" (Id. at 17-18.) In other words, termination of the landline path occurs when the PCC 101 relocates from the cordless telephone system to the cellular telephone system 103. In view of these disclosures, we are not persuaded that persons skilled in the art would not

recognize in the disclosure a description of the limitations of "automatically generating a three way call ..." and "automatically terminating a path of the three way call"

Second, the examiner alleges, "[t]he specification inadequately describes the telephone device having a telephone number as stated by claims 27, 29, 31, and 34." (Examiner's Answer at 6.) The appellants argue, "[s]upport in the specification is found, for example, on page 14, line 23 - page 18, line 2." (Appeal Br. at 8.)

Claims 27-36 specify in pertinent part the following limitations: "a telephone device having a telephone number" The examiner fails to show that the original specification, which includes the original claims, does not describe the limitations. "A patent specification is directed to one of ordinary skill in the art." Wang Labs., Inc. v. Toshiba Corp., 993 F.2d 858, 866, 26 USPQ2d 1767, 1774 (Fed. Cir. 1993) (citing In re Hayes Microcomputer Prods., Inc. Patent Litigation, 982 F.2d 1527, 1533, 25 USPQ2d 1241, 1245 (Fed. Cir. 1992)).

Here, the original specification discloses "a call in process between the PCC 101 ... and a calling party" (Spec. at 16.) One of ordinary skill in the art would know that the calling party necessarily used a telephone having a telephone number to place the call in process.

In view of this disclosure and knowledge, we are not persuaded that persons skilled in the art would not recognize in the disclosure a description of the claimed limitations of "a telephone device having a telephone number" Therefore, we reverse the rejection of claims 27-36 as lacking a written description. We proceed to the enablement rejection.

II. Enablement Rejection of Claims 27-30

We begin by noting the following principles. To fulfill the enablement requirement, a specification must contain a description that enables one skilled in the art to make and use the claimed invention. That some experimentation is necessary does not preclude enablement. All that is required

is that experimentation not be unduly extensive. Atlas Powder Co. v. E. I. Du Pont de Nemours & Co., 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984). "[T]he PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application" In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (citing In re Marzocchi, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971)). With these principles in mind, we consider the examiner's rejection.

The examiner alleges, "[t]he specification fails to provide an enabling disclosure for the step of automatically generating a three way call as stated by claims 27 and 29 and the steps of automatically terminating a path of the three way call as stated by claims 28 and 30. (Examiner's Answer at 6.) The appellants make the following argument.

[T]he claimed subject matter is described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention. The applicants submit that the specification adequately describes the step of

automatically generating a three way call as stated by claims 27 and 29 and the step of automatically terminating a path of the three way call as stated by claim [claims, sic] 28 and 30. These steps have enabling descriptions as supported in the FIGs. 7-1, 7-2 and 6-2 described in response to point 1 hereinabove and as supported in the specification, for example, at page 14, line 23 - page 18, line 2
....

(Appeal Br. at 11).

As mentioned regarding the written description rejection, claims 27-30 specify in pertinent part the following limitations: "automatically generating a three way call" As also aforementioned, claims 28 and 30 further specify in pertinent part the following limitations: "automatically terminating a path of the three way call"

The examiner fails to show that the specification does not adequately enable the claimed limitations. Even before the appellants' invention, "landline and cellular telephone companies ... provided ... Three Way Calling." (Spec. at 2.) Turning to the invention, the specification explains that the cordless base station can be implemented with "[a] conventional transmitter 301 and a conventional receiver 303,"

(id. at 8), and "a microprocessor 313, such as a 68HC11 available from Motorola, Inc., or similar microprocessor, which is coupled to conventional memory devices 315 which store the microprocessor operating program, base identification (BID) and customizing personality" (Id.) It further explains that the PCC 101 can be implemented with "a 68HC11 microprocessor, available from Motorola, Inc., [that] performs the necessary processing functions under control of programs stored in conventional ROM 421." (Id. at 9-10.) Figures 5-1, 5-2, 6-1, 6-2, 7-1, and 7-2 of the specification show flow charts of the functions described to be performed by the microprocessors. (Id. at 5.) Pages 14-18 of the specification explain the functions in detail.

In view of the prior art's provisions and the appellants' explanation and flow charts, we are not persuaded that the specification would not enable one skilled in the art to make and use the claimed invention without undue experimentation. Therefore, we reverse the rejection of claims 27-31 as non-enabled. We proceed to the utility rejection.

III. Utility Rejection of Claims 27-30

The examiner makes the following allegation.

[T]he method and the cellular telephone is incapable of either automatically generates [sic] a three way call from a call to or from the cellular system and also a call to or from the cordless system **AND ALSO** the method and the cellular cordless telephone terminates the three way call when the cordless telephone is located in the cordless telephone system or in the cellular system.

(Examiner's Answer at 7.) The appellants make the following argument.

[T]he step of automatically generating a three way call as claim [sic] by claims 27 and 39 and the step of automatically terminating a path of the three way call as claim [sic] by claims 28 and 30 are operative and have utility. These steps are operative and have utility as supported in the FIGs. 7-1, 7-2 and 6-2 described ... hereinabove and as supported in the specification, for example, at page 14, line 23 - page 18, line 2 described ... hereinabove. In response to the examiner's statements, the applicants further note that the claimed steps of "automatically terminating a path of the three way call" in claim 28 are *further* steps of the claimed method in claim 27 and do not negate the claimed step of "automatically generating a three way call" in claim 27.

(Appeal Br. at 12-13.)

As mentioned regarding the enablement rejection, we are not persuaded that the specification would not enable one

skilled in the art to make and use the claimed invention without undue experimentation. For the same reasons, we are not persuaded that claims 27-30 are inoperative to lack utility. Therefore, we reverse the rejection of claims 27-30 as lacking utility. We proceed to the anticipation rejection.

IV. Anticipation Rejection of Claims 31-36

We begin by noting the following principles from Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

A prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "[A]bsence from the reference of any claimed element negates anticipation." Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

We also note that, in general, claims that are not argued separately stand or fall together. In re Kaslow, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983). When the patentability of dependent claims in particular is not argued separately, the claims stand or fall with the claims from which they depend. In re King, 801 F.2d 1324, 1325, 231 USPQ

136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

Here, the appellants state, "[c]laims 31-36 stand or fall together." (Appeal Br. at 6.) Therefore, we consider these claims to stand or fall as a group and select claim 31 to represent the group. With this representation in mind, we consider the appellants' argument.

The appellants argue, "the preferred embodiment of the priority document³ does not teach or suggest 'automatically assigning a route for an incoming call, before the incoming call is generated...'" (Appeal Br. at 13.) The examiner replies by referencing the description of Figure 6, which is common to the Gillig references. (Examiner's Answer at 24-26.)

"In the patentability context, claims are to be given their broadest reasonable interpretations. Moreover,

³The appellants call Gillig '230 the "priority document" (Appeal Br. at 13.)

limitations are not to be read into the claims from the specification." In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993)(citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). Furthermore, "when interpreting a claim, words of the claim are generally given their ordinary and accustomed meaning, unless it appears from the specification or the file history that they were used differently by the inventor." In re Paulsen, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (citing Carroll Touch, Inc. v. Electro Mechanical Sys., Inc., 15 F.3d 1573, 1577, 27 USPQ2d 1836, 1840 (Fed. Cir. 1993)).

Here, representative claim 31 specifies in pertinent part the following limitation: "automatically assigning a route for an incoming call" Because neither the specification nor the file history defines the term "automatically" nor suggests that the appellants sought to assign a meaning to the term different from its ordinary and accustomed meaning, that is the meaning we must give it. Something that is automatic is defined as "operating by its own mechanism when actuated by

some impersonal influence ...; not manual, without personal intervention." IEEE Standard Dictionary of Electrical and Electronics Terms 39 (2d ed. 1997)(copy attached). Giving the claim its broadest reasonable interpretation in view of this definition, the limitation recite assigning a route for an incoming call without manual intervention.

The Gillig references teach the limitation. Specifically, the references disclose a "process used by the cellular cordless telephones in FIGS. 2 and 3 for receiving a telephone call as a cellular telephone call or a cordless telephone call according to user selectable preference." Gillig '230, col. 1, ll. 57-61; Gillig '042, col. 1, ll. 61-65; Gillig '558, col. 1, l. 66 - col. 2, l. 2; Gillig '674, col. 2, ll. 5-8; and Gillig '506, col. 2, ll. 3-6. Figure 6 of each of the Gillig references shows that the process receives an incoming call (502) and assigns it a route corresponding to either a cellular connection (512) or a cordless connection (510). Although the process considers a user's selectable preference (504), the figure further shows

that it operates without manual intervention once the selection is made.

Because the incoming call is assigned to a cellular or cordless connection without manual intervention once a user's selectable preference is made, we are persuaded that the Gillig references teach the limitation of "automatically assigning a route for an incoming call" Therefore, we affirm the rejection of claims 31-36 as anticipated by Gillig '230, Gillig '042, Gillig '558, Gillig '674, and Gillig '560. We proceed to the obviousness rejection.

V. Obviousness Rejection of Claims 27-29

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).... "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d

1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Also, the references represent the level of ordinary skill in the art. See In re GPAC Inc., 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995)(finding that the Board of Patent Appeals and Interference did not err in concluding that the level of ordinary skill was best determined by the references of record); In re Oelrich, 579 F.2d 86, 91, 198 USPQ 210, 214 (CCPA 1978) ("[T]he PTO usually must evaluate ... the level of ordinary skill solely on the cold words of the literature."). Of course, "[e]very patent application and reference relies to some extent upon knowledge of persons skilled in the art to complement that [which is] disclosed'" In re Bode, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977) (quoting In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 424 (CCPA 1973)). Those persons "must be presumed to know something" about the art "apart from what the references disclose." In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). With these principles in mind, we consider the appellants' three arguments.

First, the appellants argue, "[n]owhere in the preferred embodiment of the priority document does the priority document teach or suggest using *one transceiver* to originate [sic] and receive calls in both the cordless and cellular telephone systems." (Appeal Br. at 14.) Claims 27-29 specify in pertinent part the following limitations: "a transceiver, ... originating and receiving cellular calls, using the transceiver ...; originating and receiving cordless calls, using the transceiver" Giving the claims their broadest reasonable interpretation, the limitations can include using several transmitters and receivers to originate and receive calls in cordless and cellular telephone systems.

The Gillig references would have suggested the limitations. Specifically, Figure 2 of each of the references shows a cordless receiver 112, a cordless transmitter 114, a cellular receiver 122, and a cellular transmitter 124. Similarly, Figure 3 of each of the Gillig references depicts a cordless receiver 214, a cordless transmitter 212, a cellular receiver 224, and a cellular transmitter 222.

Because the Gillig references use several transmitters and receivers to originate and receive calls in cordless and cellular telephone systems, we are persuaded that teachings from the prior art would have suggested the limitations of "a transceiver, ... originating and receiving cellular calls, using the transceiver ...; originating and receiving cordless calls, using the transceiver"

Second, the appellants make the following argument.

[T]he preferred embodiment of the priority document does not teach or suggest the step of "automatically generating a three way call between the telephone device having the telephone number, the cellular cordless telephone having the cellular telephone number and the telephone landline having the landline telephone number responsive to the step of detecting," as claimed in claim 27

(Appeal Br. at 15.) Claims 27-29 each specify in pertinent part the following limitations:

detecting movement of the cellular cordless telephone between the cellular telephone system and the cordless telephone system; and

automatically generating a three way call between the telephone device having the telephone number, the cellular cordless telephone having the cellular telephone number and the telephone landline having the landline telephone number responsive to the step of detecting.

Giving the claims their broadest reasonable interpretation, the limitations recite generating a three way call in response to detecting movement of a cellular cordless telephone between a cellular telephone system and a cordless telephone system.

The Gillig references would have suggested the limitations. Specifically, Figure 8 of each of the references shows a process for automatically transferring a call in-process on a cellular cordless telephone (CCT) between a cellular telephone system and a cordless telephone system. The process includes detecting movement of the CCT from the cellular system to the cordless system (706) and vice versa (708). In response to the detection, the process transfers a cellular call to the cordless system (718) or a cordless call to the cellular system (714), respectively. Figure 7 of each of the Gillig references, moreover, shows generating a three way call (616). In addition, the appellants admit that it was known to use three way calling to solve the problem of a user who moves between a cordless telephone system and a cellular telephone system missing an incoming call routed to the system

where he is not found. Specifically, "[i]n the prior art, landline and cellular telephone companies have provided a solution to this problem with features known as ... Three Way Calling." (Spec. at 2.)

Because the Gillig references disclose generating a three way call and also detecting movement of the CCT from the cellular system to the cordless system and vice versa, and the prior art used three way calling to solve the problem of a user who moves between a cordless telephone system and a cellular telephone system missing an incoming call routed to the system where he is not found, we are persuaded that the teachings from the prior art would have suggested the claimed limitations of "detecting movement of the cellular cordless telephone between the cellular telephone system and the cordless telephone system; and automatically generating a three way call ... responsive to the step of detecting." Therefore, we affirm the rejection of claims 27 and 29 as obvious over Gillig '230, Gillig '042, Gillig '558, or Gillig '674.

Third, the appellants make the following argument.

Further, the preferred embodiment of the priority document does not teach or suggest the steps of: "automatically terminating a path of the three way call between the telephone device having the telephone number and the cellular cordless telephone having the cellular telephone number when the cellular cordless telephone is located in the cordless telephone system; and automatically terminating a path of the three way call between the telephone device having the telephone number and the telephone landline having the landline telephone number when the cellular cordless telephone is located in the cellular telephone system," as claimed in claim 28"

(Appeal Br. at 15). Claim 28 specifies in pertinent part the following limitations:

automatically terminating a path of the three way call between the telephone device having the telephone number and the cellular cordless telephone having the cellular telephone number when the cellular cordless telephone is located in the cordless telephone system; and

automatically terminating a path of the three way call between the telephone device having the telephone number and the telephone landline having the landline telephone number when the cellular cordless telephone is located in the cellular telephone system.

The examiner fails to show a suggestion of the limitations in the prior art of record. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS

Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995)(citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." Id. at 1266, 23 USPQ2d at 1784, (citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

Here, none of the Gillig references teaches terminating a path of a three way call at all, let alone terminating a path between a calling party and a cellular cordless telephone having a cellular telephone number when the telephone is located in a cordless telephone system or terminating a path

between the calling party and a telephone landline when the cellular cordless telephone is located in a cellular telephone system. Because the Gillig references fail to disclose terminating a path of a three way call, we are not persuaded that the teachings from the prior art would appear to have suggested the limitations of "automatically terminating a path of the three way call between the telephone device having the telephone number and the cellular cordless telephone having the cellular telephone number when the cellular cordless telephone is located in the cordless telephone system" and "automatically terminating a path of the three way call between the telephone device having the telephone phone number and the telephone landline having the landline telephone number when the cellular cordless telephone is located in the cellular telephone system." Therefore, we reverse the rejection of claim 28 as obvious over Gillig '230, Gillig '042, Gillig '558, or Gillig '674.

We end by noting that our affirmances are based only on the arguments made in the brief. Arguments not made therein are neither before us nor at issue but are considered waived.

CONCLUSION

In summary, the rejections of claims 27-36 under § 112, ¶ 1; of claims 27-30 under § 101; and of claim 28 under § 103(a) are reversed. The rejections of claims 31-36 under § 102(b)and §102(e) and of claims 27 and 29 under § 103(a), however, are affirmed.

No period of time for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS
Administrative Patent Judge)	AND
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LANCE LEONARD BARRY)	
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LLB/kis
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MOTOROLA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
600 NORTH U.S. HIGHWAY 45
LIBERTYVILLE, IL 60048

Appeall No. 1998-1398
Application No. 08/400,637

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